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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER				
BELIVEAU, SCOTT E				
ART UNIT		PAPER NUMBER		
2614				

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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/590,417

Applicant(s)

TILFORD, ARTHUR R.

Examiner

Scott Beliveau

Art Unit

2614

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 December 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY (check either a) or b))

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - b) ☐ they raise the issue of new matter (see Note below);
 - c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.
- NOTE: _____
3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-34.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 7.
10. ☐ Other: _____

ADVISORY ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 6 November 2003 was filed after the mailing date of the Final Rejection on 1 October 2003. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Request for Reconsideration

2. The shortened statutory period for reply expires THREE MONTHS from the mailing date of the final rejection or as of the mailing date of this advisory action, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. Any extension fee required pursuant to 37 CFR 1.17 will be calculated from the date that the shortened statutory period for reply expires as set forth above.
3. Pursuant to applicant's arguments filed 9 December 2003, with respect to the objection to the drawings and non-art rejections (Section II), the request for reconsideration has been entered and considered. Applicant's arguments have been fully considered and are persuasive. The rejection of claim 33 under 35 U.S.C. 112 and the objection to the drawings have been withdrawn.
4. The request for reconsideration has been entered and considered but does not overcome the rejection under 35 U.S.C. 103(a) over Perlman (US Pat No. 6,169,879), in view of the PocketTV™ article.

With respect to the applicant's remarks reasserting arguments previously presented pertaining to the capability for a handheld computing device to transmit audio /visual information to a set top box, the examiner respectfully disagrees as set forth in the Final Rejection, Paper No. 6.

As aforementioned, the HP Jornada 430se platform referenced by the PocketTV™ article inherently supports the ability to both transmit and receive data to/from the device (HP Jornada: User Guide – Page 8) such as the “computer” of Perlman (Col 6, Lines 49-60). Subsequently, the examiner is unclear as to how in particular the PocketTV™ article is necessarily teaching away from transmitting information to a set top box given that the embodiment clearly supports or is capable of the transfer of information/data both to and from the device to other devices as evidenced by the HP Jornada: User Guide. Given the ubiquity of devices operable to playback the standardized MPEG compressed video, it is the examiner's opinion that one having ordinary skill in the art or an owner of the HP Jornada would recognize and/or be clearly capable of transmitting files regardless of their particular format (ex. text, MPEG, spreadsheets, etc.) both to/from their “handheld computing device”. Applicant's remarks would appear to suggest that a user, in light of the combined references, would be allowed or capable of sending information from the “set-top box” or computer to the “hand held computer device”, but would subsequently be restricted from sending that same data to the same or another device. The art is replete with PDA applications wherein user may “synch” or transmit information stored on a PDA to an external device for viewing. As is within the knowledge of one having ordinary skill in the art, Microsoft has a number of PDA versions its popular Microsoft® Office® software wherein a user may transmit

spreadsheets or word processing documents to the PDA, made modifications, and then transmit them back to the computer for further viewing and/or modification. The HP Jornada User Guide clearly states that the device facilitates the transfer of data both to and from the "handheld computer device". Accordingly, it is the examiner's opinion that it is well within the scope of knowledge generally available to one of ordinary skill in the art at the time of the invention to recognize that a user of the PocketTV® software in conjunction with a HP Jornada 430se would be capable of both the sending and receiving of files regardless of format to/from external devices.

With respect to the request for reconsideration pertaining to arguments addressing the Perlman VCR [130] equating to the claimed "hand held computing device", these arguments have not been considered because good and sufficient reasons why it was not earlier presented have not been shown. In particular, the rejection clearly states that in conjunction with the Perlman reference that "it is arguable that the VCR [130] may be broadly construed as being a hand held computing device . . ." and "assuming arguendo" to the contrary, the "PocketTV™" article is utilized as evidence of a "hand held computing device" acting as a VCR. Accordingly, it is the examiner's opinion that the applicant was adequately afforded the opportunity to previously present such arguments in conjunction with the traversal of the rejection as applied to Perlman presented in conjunction with the Non-Final rejection. The failure of the applicant to fully consider and address the grounds of rejection previously set forth by implying that certain portions/sections of the examiner's rejection were "hidden in the text of the rejection" while other sections were clearly considered and addressed in conjunction with applicant's previous traversal of the combination of the Perlman in view of

the PocketTV™ article (Paper No. 5) is, in the examiner's opinion, in itself is not construed as good and sufficient reasons as to why such arguments were not set forth earlier in prosecution.

With respect to applicant's remarks traversing the examiner's equating of the Perlman's central electronics device [40] with a set top box, the Perlman reference explicitly discloses that the central electronic device can be a WebTV box (Col 8, Lines 12-14) that may further support the tuning of channels (Col 10, Lines 61-64). Furthermore, as defined in the Microsoft Computer Dictionary 5th Edition a WebTV is a "system that provides consumers with the ability to access the Web as well as send and receive e-mail on a television by means of a set-top box equipped with a modem".

With respect to the applicant's remarks pertaining to the Perlman reference failing to describe the usage of a handheld computing device as claimed, it is noted that the claim is not limiting such that a "handheld computing device" is strictly limited to that of a PDA or Pocket-PC. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). With respect to the usage/citation of the HP Jornada reference, a second or any subsequent action on the merits in any application will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement, of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art. In the case of the instant application, the applicant amended all of the independent claims, thereby allowing entry of new citations including and in particular those further illustrated

inherent features of the HP Jornada 430se device for which the applicant asserted the device was not capable of facilitating.

The Perlman reference is generally directed towards the interconnection of consumer electronic devices wherein "consumer electronic device" as set forth in Perlman may refer to "any number or type of various consumer electronic devices that provide audio output, video output, or information services (Col 6, Lines 45-60). In this context, a "handheld computer device" or PDA such as described in the PocketTV™ article meets the definition of a consumer electronic device in so far as the PocketTV™ is a device that provides both audio and video output. Accordingly, it is the examiner's opinion that there is sufficient motivation and/or suggestion to utilize the "hand held computing device" such as that described in the PocketTV™ article in conjunction with the Perlman embodiment.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The hypothetical combination, of the Perlman and PocketTV™ reference, as noted by the applicant, would result in receiving information in the PocketTV™ device from a VCR or cable box through the central electronics device for playback on the PocketTV™. Accordingly, the only limitations in the independent claims apparently not disclosed by the applicant's combination appear to be those related to "transmitting" and "providing" the information from the "handheld computing device" to a set top box for subsequent display. The Perlman reference clearly discloses that the VCR [130] is operable to "store" the "audio/video information"

from any of the connected sources and to subsequently "transmit" the stored material to the "set top box" [40] for display on an "output device" [110] (Col 9, Lines 58-61). The PocketTV™ article clearly discloses that a "hand held computing device" such as the HP Jornada 430se using the PocketTV™ software becomes a VCR, which as taught by Perlman and recognizable to one having ordinary skill in the art is operable to receive and play back audio/visual data. As evidenced by the User Guide for the Jornada 430se, the "hand held computing device" is clearly operable or capable of transmitting data both to and from the device. Accordingly, it is the examiner's opinion that such a combination would be result in an operable embodiment wherein the PocketTV™ disclosed "hand held computer device" provides the VCR functionality of the Perlman reference, including the ability to both "transmit" and "receive" audio/visual information using a device that is advantageously portable and meets the claimed limitations. As aforementioned, in the previous rejection, such a combination would further advantageously facilitate providing the video display on a larger screen than that of the PocketTV™ that is easier to view.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907. The examiner can normally be reached on Monday-Friday from 9:00 a.m. - 6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone numbers for the


Art Unit: 2614

organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-HELP.

SEB

December 11, 2003


JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600